Attorney's Docket No.: 07844-501001
Client's Ref. No.: P464

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OCT 19 2005

Number of pages including this page   7

Applicant : R. Perelman, et al.   Art Unit : 2151
Serial No. : 10/006,260   Examiner : Backhean Tiv
Filed   : November 2, 2001

Title   : CLIENT-SIDE MODIFICATION OF ELECTRONIC DOCUMENTS IN A
           CLIENT-SERVER ENVIRONMENT

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached to this facsimile communication cover sheet is PRE-APPEAL BRIEF

REQUEST FOR REVIEW AND ATTACHMENT PAGES, faxed this 19th day of October, 2005,

to the United States Patent and Trademark Office.

Respectfully submitted,

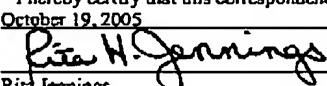Date: October 19, 2005

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10562860.doc

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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number: 07844-501001	**RECEIVED CENTRAL FAX CENTER** **OCT 19 2005**
I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.	Application Number 10/006,260	Filed November 2, 2001
	First Named Inventor R. Perelman, et al.	
Date of Deposit	Art Unit 2151	Examiner Backhean Tiv
Signature		
Typed or Printed Name of Person Signing Certificate		

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
    is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 47,671
                    (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.
    Registration number if acting under 37 CFR 1.34

Signature

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Typed or printed name

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Telephone number

October 19, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.
I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below.
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Rita H. Jennings   (Signature)
Rita Jennings   (Typed or Printed Name of Person Signing Certificate)

☒ Total of 6 forms are submitted.

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    Attorney's Docket No.: 07844-501001 / P464

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : R. Perelman, et al.	Art Unit : 2151
Serial No. : 10/006,260	Examiner : Backhean Tiv
Filed : November 2, 2001	
Title : CLIENT-SIDE MODIFICATION OF ELECTRONIC DOCUMENTS IN A CLIENT-SERVER ENVIRONMENT	

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-40 are pending, with claims 1, 16, 24, and 32 being independent. Claims 1-40 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over D'Arlach et al. (US 6,026,433) in view of Szabo (US 6,868,525). Claims 1-40 also stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over D'Arlach et al. in view of Dilworth et al. (WO 00/51018). Reference is hereby made to the arguments already of record regarding the impropriety of these rejections; the remarks made in the responses filed April 27, 2005 and September 19, 2005 are maintained and are incorporated herein by reference.

The presently claimed subject matter is generally directed to client-side modification of electronic documents by server-generated instructions in a client-server environment. As briefly summarized in paragraph 12 of the present application, "Client-side modification of electronic

documents by server-generated instructions in a client-server environment enables dynamic modification of formatting information in an electronic document to accommodate new data received from the server. A server generates machine instructions to send to a client along with new data for an electronic document. The generated instructions modify the electronic document at the client to accommodate the new data."

As exemplified in claim 32, the claimed operations include: "receiving a request from a client; producing data corresponding to the client request; generating instructions for an electronic document having a predetermined format that defines <u>an appearance</u> of the electronic document <u>independent of a device used to present the electronic document</u>, the generated instructions specifying one or more operations to modify the predetermined format at the client to accommodate the produced data<u>, the generated instructions to be performed at the client to effect the one or more operations</u>; and transmitting the produced data and the generated instructions to the client." (Emphasis added.)

D'Arlach describes a "method for creating and editing a Web site in a client-server computer network using customizable templates." (*See* D'Arlach at Abstract.) But D'Arlach does not describe generating instructions to modify an electronic document, the generated instructions specifying one or more operations to modify the electronic document at the client to accommodate the produced data, and the generated instructions to be <u>performed at the client</u> to effect the one or more operations. Nowhere does D'Arlach describe or show generation of instructions to be performed at the client to effect the one or more operations, as claimed. D'Arlach clearly describes a system in which a client sends requests to a server, which generates documents to be sent to the client in the course of building a Web site using customizable templates. Copies of the template documents are changed in response to user requests, but D'Arlach makes very clear that <u>all such changes occur on the server computer, not</u> at the client. (*See* D'Arlach at col. 5, lines 26-32.) Thus, D'Arlach actually teaches away from generating instructions to send to a client to modify an electronic document at the client.

The Advisory Action mailed October 6, 2005 fails to address this point, but rather states, "D'Arlach teaches that a user can modify a template. The template has instructions for modification." This statement fails to address the claim limitations at issue and also fails to address the cited portion of D'Arlach (col. 5, lines 26-32), which teaches away from the

presently claimed subject matter. Thus, there is a clear legal or factual deficiency with respect to the rejections of claims 1-40 for this reason alone.

The Official Action relies on Szabo and Dilworth for the claimed electronic document having a predetermined format that defines an appearance of the electronic document independent of a device used to present the electronic document. The Advisory Action states that both the XML and HTML formats are "forms of an electronic document that defines an appearance which is independent of a device." This statement is incorrect and is not supported by the record. Szabo says nothing about the appearance of an XML document on different platforms, and in fact, an XML document will appear very differently on different platforms depending on the software used to open and display the XML document. Moreover, the assertion that an "XML or HTML page will have the same appearance on any OS" does not actually address the claimed feature.

The claim recites an electronic document having a predetermined <u>format that defines an appearance</u> of the electronic document independent of a device used to present the electronic document. The <u>format</u> of XML does not define document appearance at all. XML is by definition a general-purpose markup language that can be rendered differently in different Web browsers. As described in paragraphs 9 and 10 of the present application, the claimed electronic document (e.g., a PDF document) is generally a type of document that allows a publisher to control the look and feel of the document as seen by an end user, including the specific physical page or pages on which information appears when printed or displayed. Thus, the format should generally support and preserve all visual formatting features (e.g., fonts, graphics, color, etc.) of any source document, regardless of the source computer platform and/or software application used to create the source document. XML is in no way this type of document, and Szabo does not in any way suggest such.

Furthermore, an HTML document generally has no ability to specify which portions of the document will appear on which physical pages when printed. In fact, a publisher of an HTML document has no final control over how the document will appear to an end user, because presentation of an HTML document, either by display on a monitor or by printing, is determined by the Web browser, which interprets the HTML tags. Thus, the reference to HTML formats by Dilworth does not describe the claimed electronic document having a predetermined format that

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defines an appearance of the electronic document independent of a device used to present the electronic document.

In addition, claims 6, 21, 24, and 37 recite the feature, "the generated instructions further comprise at least one tag indicating an order in which the produced data is to be imported into the electronic document and the instructions are to be performed." The Advisory Action offers in support of the rejection of these claims, "D'Arlach teaches building and/or modifying an HTML page. One ordinary skill in the art knows that all HTML pages uses tags." While this is likely true, the Advisory Action's argument does not actually address the limitations of the claims, which recite more than just tags. D'Arlach has been thoroughly reviewed and there is no description or figure in D'Arlach that mentions or shows <u>a tag relating to an order in which to import produced data into an electronic document and to perform instructions that modify the document to accommodate the produced data.</u>

Claims 7, 22, 25, 26, 27, and 38 recite specific types of tags that (1) indicate the produced data is to be imported into the electronic document before the instructions are performed, (2) indicate the produced data is to be imported into the electronic document after the instructions are performed, or (3) indicate that at least a portion of the generated instructions are to be inserted into the electronic document. The cited portions of D'Arlach (FIGs. 4-13) are unrelated to this claimed subject matter. The Advisory Action has failed to even address the prior argument regarding these claims. Thus, the record does not support the rejection of claims 7, 22, 25, 26, 27, and 38 based on D'Arlach.

With respect to claims 4, 19, 29, and 35, the cited portion of D'Arlach (col. 5, lines 46-55) describes a server that creates a copy of a Web site template and then modifies that copy in response to user instructions. This does not describe, "adding information to <u>the</u> electronic document <u>without changing</u> pre-existing information <u>in the</u> electronic document", as claimed. To the contrary, a copy of the original template is used in D'Arlach precisely because changes are going to be made that overwrite pre-existing information; thus the pre-existing information is retained in the original document, which is not modified, for later use. The Advisory Action states in response, "D'Arlach teaches that a user can modify certain aspects of the webpage." This fails to address the actual claim language of claims 4, 19, 29, and 35. Thus, the record does not support the current rejections of claims 4, 19, 29, and 35.

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With respect to claims 5, 20, 30, and 36, the Advisory Action states, "D'Arlach teaches a webpage, inherently scripts are used for webpages." However, the claims here do not just recite a script, but rather recite that the generated instructions comprise a script. This aspect of the claimed subject matter has not been addressed by the Official Actions. With respect to claims 9 and 40, the cited portions of D'Arlach illustrate a database structure and various user's perspectives of sample display screens. Overlay of visual objects in an electronic document is neither described nor shown in D'Arlach. The Advisory Action fails to address this point.
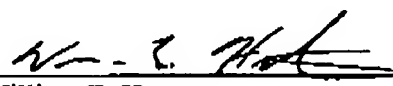
In conclusion, D'Arlach clearly describes a system in which a client sends requests to a server, which generates documents to be sent to the client in the course of building a Web site using customizable templates. D'Arlach does not teach or suggest client-side modification of electronic documents as recited in the independent claims, nor does D'Arlach teach or suggest the details of such modification of an electronic document as recited in the dependent claims. Thus, independent claims 1, 16, 24, and 32 are in condition for allowance. Moreover, dependent claims are 2-15, 17-23, 25-31, and 33-40 are allowable for at least the same reasons as their corresponding independent claims, and based on additional recitations they contain. Thus, there is a clear legal or factual deficiency with respect to the rejections of claims 1-40.

In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested.

Please apply any necessary charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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